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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,009	01/14/2004	James R. Matera JR.	1021-3 CON	3306
7590 11/28/2005			EXAMINER	
Joseph W. Schmidt Carter, DeLuca, Farrell, & Schmidt, LLP Suite 225 445 Broadhollow Road Melville, NY 11747			EREZO, DARWIN P	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 11/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Tenth

Office Action Summary

Application No.

10/757,009

Applicant(s)

MATERA, JAMES R.

Examiner

Darwin P. Erez

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by US 4,719,825 to LaHaye et al.

LaHaye teaches a surgical procedure comprising the steps of positioning an ink dispensing instrument **10** having sterilized tattoo ink therein adjacent a patient (col. 3, lines 1-6); releasing the tattoo ink through a port (hole within needle **12**) of the ink dispensing instrument and onto body tissue of a patient to selectively mark the body tissue to generally correspond to a target location for radiation therapy (col. 3, line 60); and dispensing the ink dispensing instrument after use on the patient since it is inherent in the surgical art to dispose surgical needles after use for safety reasons. Moreover, LaHaye teaches in the abstract and in col. 3, lines 9-13 that the instrument is disposable and that it is replaced with another syringe after dispensing the tattoo ink.

3. Claims 11-16 and 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,056,737 to Rosen.

(claims 11, 21 and 22) Rosen teaches a surgical procedure comprising the steps of positioning an ink dispensing instrument **10** having sterilized tattoo ink therein adjacent a patient (col. 5, lines 42-43); releasing the tattoo ink through a port **44** of the ink dispensing instrument and onto body tissue of a patient to selectively mark the body tissue to generally correspond to a target location for radiation therapy; and dispensing the ink dispensing instrument after use on the patient (Rosen teaches a single-use disposable device; col. 2, line 62). Rosen also teaches using the device for indicating an area of skin for radiation therapy (col. 8, lines 16-17). Therefore, it would be inherent that since a skin is marked for radiation therapy, that radiation therapy will be performed on the skin.

(claims 12 and 20) Rosen teaches a surgical dispensing instrument comprising an ink cartridge **10** defining an enclosed internal chamber; and a sterile tattoo ink **33** disposed within the enclosed internal chamber of the ink cartridge; wherein the device is disposable; and wherein the ink cartridge is a flexible ink cartridge (col. 2, lines 65-67). Rosen also teaches the device as a single-use disposable device (col. 2, line 62).

(claim 13) Rosen teaches the ink cartridge defining a port **44** in communication with the internal chamber.

(claim 14) Rosen teaches an enclosure **40** covering the port.

(claim 15) Rosen teaches a releasably mounted ink cartridge.

(claim 16) Rosen teaches enclosure **40** as an end cap.

4. Claims 12, 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,197,034 to Gvozdic et al.

Gvozdic teaches a surgical dispensing instrument comprising an ink cartridge **2** defining an enclosed internal chamber; and a sterile tattoo ink **6** disposed within the enclosed internal chamber of the ink cartridge; wherein the device is disposable (col. 8, lines 45-48); and wherein the ink cartridge is a flexible ink cartridge. As seen in Fig. 7, button 18 presses the cartridge to dispense ink. Therefore, the cartridge itself is fully capable of being squeezed by a user to dispense ink without the use of tool 13. Gvozdic also teaches the use of a surgical needle in an embodiment shown in Fig. 3, which is used to penetrate tissue. This needle is in communication with the port of the ink cartridge.

Response to Arguments

Applicant's arguments filed 9/9/05 has been fully considered but they are not persuasive.

With regards to applicant's arguments regarding the rejection of claim 11 under the LaHaye reference, it should be noted that LaHaye teaches a disposable syringe that is replaceable after dispensing the tattoo ink in order to allow sterile replacement of the syringe (col. 3, lines 9-13).

With regards to applicant's arguments regarding the Rosen reference, it should be noted that the common definition of "tattoo" in the art is skin marking. Therefore, the ink solution taught by Rosen is a tattoo ink since it is able to mark a skin. Rosen also teaches a single use disposable device, as mentioned in the rejections above.

Applicant's arguments with respect to claims 18 and 19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. 0-6Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who's telephone number is (571) 272-4695. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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GLEN K. DAWSON
PRIMARY EXAMINER